

#### **REMARKS/ARGUMENTS**

Claims 1-15 are pending in the present application. Claims 1-13 were rejected in the Office Action dated January 29, 2003. Claims 14-15 are being added in the present Amendment.

#### **Abstract**

The Office Action dated January 29, 2003, objected that the present application did not include an abstract. The Office Action stated that Applicants should provide an Abstract on a separate sheet. Applicants have provided the Abstract on a separate sheet submitted with this Amendment. The Abstract is supported by the originally-filed specification at, for example, page 2, lines 10-16 and 24-30.

#### **Indefiniteness Rejections under 35 U.S.C. §112**

The Office Action of January 29, 2003, rejected claims 1-13 for indefiniteness under 35 U.S.C. § 112. The Office Action stated that the term "quantity" in those claims is indefinite. Claims 1, 6 and 10 have been amended such that the objectionable claim language has been deleted. Applicants submit that this amendment eliminates unnecessary verbiage and does not narrow the claims.

**Anticipation Rejections under 35 U.S.C. 102(b)**

Claims 1-4, 6-8, and 10-13 were rejected under 35 U.S.C. §102(b) as anticipated by International Publication No. WO 93/04118. Claims 1-4, 6-8 and 10-13 were also rejected under 35 U.S.C. §102(b) as anticipated by Christiani U.S. Patent No. 5,747,560. Claims 1, 4, 6, 8, 10, and 13 were also rejected under 35 U.S.C. §102(b) as anticipated by International Pub. No. WO 99/03914. Claims 1, 4, 6, 8, 10, and 13 were also rejected under 35 U.S.C. §102(b) as anticipated by International Pub. No. WO 98/29499. Claims 10 and 13 were also rejected under 35 U.S.C. §102(b) as anticipated by Beall et al. U.S. Patent No. 5,830,528.

Claims 5 and 9 were not rejected as being anticipated by any reference, though the Office Action rejected claims 5 and 9 as obvious over Int'l Pub. No. WO 93/04118, Christiani et al. U.S. Patent No. 5,747,560, Int'l Pub. No. WO 99/03914, or Int'l Pub. No. WO 98/29499. However, the Office Action acknowledged that claims 5 and 9 were not anticipated by any of these references. The Office Action stated "none of the references specifically discloses that the articles are suitable for use as a closure or a sealant for such a container." (Office Action, page 6).

Applicant has amended claims 1 and 6 so that they include the subject matter of claims 5 and 9, respectively. Applicant submits that amended claims 1 and 6 are not anticipated by any of

the cited references, since amended claims 1 and 6 now have the same scope as original claims 5 and 9, which are not deemed anticipated in the Office Action. (Claims 5 and 9 have been cancelled without prejudice or waiver in favor of amended claims 1 and 6, respectively.) Claims 2-4 and 7-8 depend from amended claims 1 and 6, respectively. Hence, claims 2-4 and 7-8 can no longer be considered to be anticipated by those references.

Applicant has also amended claim 10 to specify that the method relates to decreasing the gas permeability of a beverage container closure. New claim 14 relates to decreasing the gas permeability of a beverage container sealant layer. Since the cited references do not disclose articles suitable for use as a closure or a sealant for such a container, claims 10-15 cannot be anticipated by those references.

**Obviousness Rejections under 35 U.S.C. 103(a)**

Claims 5 and 9 were rejected under 103(a) as obvious in view of Int'l Pub. No. WO 93/04118, or Christiani et al., or Int'l Pub. No. WO 99/03914, or Int'l Pub. No. WO 98/29499. However, as noted above, the Office Action acknowledged that "none of the references specifically discloses that the articles are suitable for use as a closure or a sealant for such a container." (Office Action, page 6). Nonetheless, the Office Action concluded that it would have been obvious to one of ordinary skill in the art to

utilize the composition of of Int'l Pub. No. WO 93/04118, or Christiani et al., or Int'l Pub. No. WO 99/03914, or Int'l Pub. No. WO 98/29499 in any portion of a container including closure or sealant layer.

Applicant submits that the subject matter of the rejected claims would not have been obvious to one of ordinary skill in the art at the time the invention was made. First, the cited references do not disclose or suggest all the elements of the pending claims. Second, the Office Action does not identify any motivation or suggestion to modify the cited references.

The Office Action acknowledged that the four cited references do not disclose "that the articles are suitable for use as a closure or sealant for such a container." (Office Action, page 6). However, the Office Action stated:

However, given the generic disclosure of container by WO 93/04118, Christiani et al., WO 99/03914, or WO 98/29499 as well as the disclosure in each reference that the compositions decrease gas permeability of thermoplastic material, it therefore would have been obvious to one of ordinary skill in the art to utilize the composition of WO 93/04118, Christiani et al., WO 99/03914, or WO 98/29499 in any portion of the container including closure or sealant layer as presently claimed, where it is important that gas permeability is decreased in order to preserve the beverage inside the container, and thereby arrive at the claimed invention.

Office Action, page 6).

The Office Action itself acknowledges that the cited references do not disclose all the elements of the pending claims, in that they do not contain any disclosure of beverage container closures or sealant layers. Instead, the Office Action relies of the references' teachings regarding containers in general and the desire to decrease gas permeability. However, the failure of the cited references to make any mention of the use of melt-processible compositions for beverage container closures or sealant layers is significant evidence that the pending claims are NOT obvious.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." Manual of Patent Examining Procedure, section 2143.03 (8th Ed., 1st Rev., Feb. 2003). Thus, the *prima facie* obviousness requires that the prior art teach or suggest the claimed melt-processible compositions for beverage container closures or sealant layers. The Office Action does not identify any such teaching or suggestion of those claim elements.

Even though the several references cited by the Office Action discuss melt-processible compositions for containers, none of those references discloses material for use as a beverage container closure or a beverage container sealant layer. Thus, any disclosure of containers and decreased gas permeability

cannot be considered evidence of obviousness or a suggestion of closures or sealant layers. To the contrary, the fact that several inventors failed to observe potential for beverage container closures and sealant layers, even after discussing containers, is strong evidence of nonobviousness.

Secondly, the Office Action has failed to set forth any motivation or suggestion to modify the cited references so as to apply to a beverage container closure or sealant layer. A prima facie case of obviousness requires "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." Manual of Patent Examining Procedure, section 2142 (8th Ed., 1st Rev., Feb. 2003). The Court of Appeals for the Federal Circuit has cautioned against the substitution of hindsight for a suggestion or motivation to modify the prior art:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

*In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

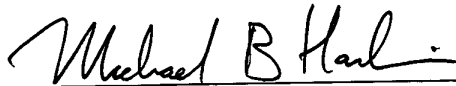
Applicant submits that the Office Action dated January 29, 2003 used hindsight to conclude that it would have been obvious to modify the teachings of the cited references by applying them to beverage container closure or a beverage container sealant layer. The Office Action does not state why one would have the idea of using the teachings of the cited references for closures or sealant layers or why such use is not disclosed in the cited references. It is only Applicant's disclosure of his presently claimed invention that makes it appear that the cited references suggest using their teachings for closures and sealant layers. This is, as in *Dembiczak*, the essence of hindsight.

\* \* \* \* \*

In view of the foregoing amendments and remarks, applicants submit that claims 1-15 are allowable. The Examiner is invited to telephone the applicants' undersigned attorney at (312) 775-8202 if any unresolved matters remain.

Please charge any fees incurred in connection with this submission to Deposit Account No. 13-0017.

Respectfully submitted,

A handwritten signature in cursive script, reading "Michael B. Harlin", written over a horizontal line.

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